

REMARKS

Election/Restriction – Groups I and II

Examiner requires Restriction under 35 U.S.C. 121 requiring Applicants to restrict the instant application to one of the following 2 groups:

- Group I Claims 1-16, drawn to a photovoltaic device
- Group II Claims 17-27, drawn to a process of making a photovoltaic device

Applicants provisionally Elect the Claims of Group II but respectfully traverse this Restriction requirement. The Examiner states as basis for this Restriction requirement that “the product as claimed can be made by another and materially different process. For instance, the doping of a first layer can take place after an additional layer has been deposited on the top layer.”

Applicants respectfully point out that the doping of a first layer after an additional layer has been deposited on the top layer to make an identical product would not be a materially different process. No order of process steps is specified in the Claims currently presented in the instant Application. Even if an order was specified, a claim directed to a process of making the identical product having the first layer being doped after an additional layer has been deposited would not materially affect the search and examination of the instant Application.

Because the Examiner has not alleged a materially different process for making the claimed product, the Applicants respectfully request that the Restriction requirement be withdrawn.

Species – Groups I & II

The Examiner further asserts that Group I contains claims directed to 2 patentably distinct species (referred to as Species Ia and Species Ib) and Group II contains claims directed to 3 patentably distinct species (referred to as Species IIa, IIb and IIc). The Examiner requires Applicants to elect a single species for prosecution on the merits. Applicants respectfully traverse this requirement.

The Examiner has used form paragraph ¶ 8.01 (found in MPEP § 809.02(a)) which sets forth an election of species requirement under MPEP § 809.02 but has also asserted that no claim is generic (Office Action page 3) which would make MPEP § 809 inapplicable. The provision applicable to an

application having distinct species and no generic claim is MPEP § 808 but a requirement under MPEP § 808 would not be set forth using ¶ 8.01 so the Office Action was unclear as to whether the Examiner was asking for an election of species under MPEP § 809 or a restriction between species under MPEP § 808 and was further unclear as to whether the species were considered independent (MPEP § 808.01) or related (MPEP § 808.02).

A telephone conversation with the Examiner was conducted on June 15, 2005 to clarify whether the Examiner was requiring an election of species under MPEP § 809 or a restriction between species under MPEP § 808. Although no explicit resolution was reached as to which section was being applied, the Examiner explained that the species are related (not independent) but patentably distinct and agreed that there is no generic claim embracing any of the species.

Applicants strenuously object to being asked to respond to this portion of the Office Action without the Examiner clearly setting forth the basis for this portion of the Office Action. However, in order to further the prosecution of this Application, Applicants provisionally elect Species IIa (claims 17-21) and Applicants will traverse this requirement under MPEP § 809 and also under MPEP § 808.

Traverse on the basis of MPEP § 809. The Examiner has used form paragraph ¶ 8.01 which is to be used under MPEP § 809.02 to require an election of species. MPEP § 809.02 is not applicable in this instance. MPEP § 809.02 only applies to "an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby" (MPEP § 809.02 quoting 37 CFR 1.146 governing election of species).

Examiner asserts in the Office Action, and confirmed in the June 15 telephone conversation, that no claim is generic. Therefore, neither 37 CFR 1.146 nor MPEP § 809.02 applies and the election of species requirement is improper. Because this requirement is improper, Applicants respectfully request that the Examiner withdraw the requirement to elect a species.

Traverse on the basis of MPEP § 808. In the June 15 2005 phone conversation, Examiner asserted that the species are related (not independent) and reasserted that the species are patentably distinct. The Examiner also reasserted that no claim is generic. In the case where an application presents

related but patentably distinct species with no generic claim, MPEP § 808.02 is the applicable provision. However, the Examiner has not set forth any of the necessary showings under § MPEP 808.02 to require restriction in such a case.

For an Examiner to require restriction between related patentably distinct species, MPEP § 808.02 states that the Examiner must show that the inventions either (i) have separate classifications, or (ii) are classified together but are recognized as separate subjects for inventive effort, or (iii) are subject to different fields of search.

MPEP § 808.02 states in its concluding paragraph "Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions" (emphasis added).

Because the Examiner has not made the necessary showing under MPEP § 808.02, Applicants respectfully request that the Examiner withdraw this requirement.

Applicants and their undersigned Attorney appreciate Examiner's attention and further consideration of this matter.

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Respectfully submitted,



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